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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,668	02/14/2006	Ansgar Behler	C 2682 PCT/US	4666

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PATENT DEPARTMENT
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EXAMINER	
MRUK, BRIAN P	
ART UNIT	**PAPER NUMBER**
1751	

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/539,668	BEHLER ET AL.	
	Examiner	Art Unit	
	Brian P. Mruk	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/14/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Oath/Declaration

2. The examiner notes that the Oath is missing from the instant application. The examiner requests that applicant submit an additional copy of the original Oath in their next response.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 11-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Milstein et al, WO 97/42299.

Milstein et al, WO 97/42299, discloses a process for making an alkyl ether carboxylate comprising providing an alkyl polyglycoside of formula II, providing an alkali metal compound, and adding an acetate to the mixture (see abstract and page 3, lines 1-21). It is further taught by Milstein et al that a preferred alkyl polyglycoside of formula II is wherein R_1 is a 12-16 carbon atom radical, b is zero, and a is 1.4 (see page 7, lines 6-8), that the acetate is sodium monochloroacetate and the alkali metal compound is sodium hydroxide (see page 8, lines 1-7), and that the reaction occurs at a temperature

of 70-90 degrees Celsius and at a pH of 10-14 (see page 8, lines 8-13), per the requirements of the instant invention. Specifically, note Example 1. Therefore, instant claims 11-30 are anticipated by Milstein et al, WO 97/42299.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

6. Claims 11-30 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schmid et al, US 2004/0136939.

Schmid et al, US 2004/0136939, discloses a method for producing surface active agent mixtures comprising mixing an aqueous solution of an alkyl and/or alkenyl oligoglycoside with a halocarboxylic (see abstract and paragraphs [0004-0005]). It is further taught by Schmid et al that the oligoglycoside is of formula I (see paragraphs [0007-0009]), and that the halocarboxylic acid is monochloroacetate (see paragraph [0011]). Schmid et al further discloses that the alkyl and/or alkenyl oligoglycoside ether carboxylic acid is made by mixing an aqueous solution of the alkyl and/or alkenyl oligoglycoside in an amount of 50-60% by weight with sodium hydroxide and monochloroacetate at a temperature of 50-100 degrees Celsius (see paragraphs [0012-0017]), per the requirements of the instant invention. Specifically, note Examples 1-2. The examiner asserts that the surfactants made in Examples 1-2 of Schmid et al would inherently meet the pH requirements of the instant invention, since the processes

disclosed in Examples 1-2 of Schmid et al contain sufficient amounts of sodium hydroxide to achieve a pH of 10-14, absent a showing otherwise. Therefore, instant claims 11-30 are anticipated by Schmid et al, US 2004/0136939.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

7. Claims 11-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Behler et al, DE 10122255.

Behler et al, DE 10122255 (equivalent of Schmid et al, US 2004/0136939), discloses a method for producing surface active agent mixtures comprising mixing an aqueous solution of an alkyl and/or alkenyl oligoglycoside with a halocarboxylic (see abstract and paragraphs [0004-0005]). It is further taught by Behler et al that the oligoglycoside is of formula I (see paragraphs [0006-0007]), and that the halocarboxylic acid is monochloroacetate (see paragraph [0008]). Behler et al further discloses that the alkyl and/or alkenyl oligoglycoside ether carboxylic acid is made by mixing an aqueous solution of the alkyl and/or alkenyl oligoglycoside in an amount of 50-60% by weight with sodium hydroxide and monochloroacetate at a temperature of 50-100

degrees Celsius (see paragraphs [0009-0013]), per the requirements of the instant invention. Specifically, note Examples 1-2. The examiner asserts that the surfactants made in Examples 1-2 of Behler et al would inherently meet the pH requirements of the instant invention, since the processes disclosed in Examples 1-2 of Behler et al contain sufficient amounts of sodium hydroxide to achieve a pH of 10-14, absent a showing otherwise. Therefore, instant claims 11-30 are anticipated by Behler et al, DE 10122255.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 11-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-22 of copending Application No. 10/476,593. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/476,593 claims a similar process for making an alkyl and/or alkenyl oligoglycoside ether carboxylic acid by mixing an aqueous solution of an alkyl and/or alkenyl oligoglycoside in an amount of 50-60% by weight with sodium hydroxide and monochloroacetate at a temperature of 50-100 degrees Celsius (see paragraphs claims 12-22 of copending Application No. 10/476,593), per the requirements of the instant invention. Therefore, instant claims 11-30 are an obvious formulation in view of claims 12-22 of copending Application No. 10/476,593

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00AM-5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPM
Brian P Mruk
December 1, 2006

Brian P. Mruk
Brian P Mruk
Primary Examiner
Art Unit 1751